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09/574,453	05/19/2000	Hiroshi Tanaka	FJ-2000-004-US	8724

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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/574,453

Applicant(s)

TANAKA ET AL.

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities: p. 14, line 10, “wr  
ting” should read as “writing”. Appropriate correction is required.

### Claim Rejections - 35 USC § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions. The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure *per se* or a computer program *per se*, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a “signal” representing computer program *per se*, which does not mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3-4, 7-8, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiuda (U.S. 5953008), and to Ito et al's admission of prior art (U.S. 6453071).

Regarding claim 1, Hagiuda discloses a print designating method, comprising the step of:

(1) storing (stores via main storage memory, Fig. 4), in a print designation file (image file as a source file, col. 4, lines 29-41 and col. 6, lines 21-32) in a recording medium in which a file including image data (amount of image data, col. 6, lines 21-32) is stored, print designating information to designate an image to be printed stored in the recording medium, wherein the print designating information includes:

(2) file specifying information for specifying a subject file including the image (col. 6, lines 21-32) to be printed;

(3) and file type identifying information for identifying (identifies by MPU, col. 6, lines 21-32) whether the subject file is a moving image file or a still image file, wherein if the subject file is the moving image file, the print designating information further includes scene specifying information for specifying a subject scene (thumbnail images, col. 4, lines 29-41 and col. 6, lines 33-41).

However, Hagiuda does not explicitly disclose, wherein the selected scenes of a moving images are to be printed by a printer.

Ito's admission of prior art, in the same field of endeavor for printing selected scenes of moving images, discloses the selected scenes of moving images are to be printed by the printer (col. 1, lines 54-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hagiuda as per teachings of Ito's admission of prior art because of the following reasons: (1) to provide an apparatus for editing moving images an excellent in terms of portability (Hagiuda, col. 11, lines 1-5); (2) to prevent errors in editing moving images operation (Hagiuda, col. 11, lines 14-25).

Therefore, it would have been obvious to combine Hagiuda with Ito's admission of prior art to obtain the invention as specified in claim 1.

Regarding claim 3, Hagiuda further discloses the print designating method as defined in claim 1, wherein the file type identifying information includes a format type of the subject file (type of image file, col. 6, lines 21-32).

Regarding claim 4, Hagiuda further discloses the print designating method as defined in claim 1, wherein the file type identifying information includes information directly indicating whether the subject file is the moving image file or the still image file (col. 6, lines 21-32).

Regarding claim 7, Hagiuda further discloses the print designating method as defined in claim 1, wherein the scene specifying information includes a frame number (first scene of each

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moving image file Fig. 5 & 8, col. 6, lines 21-32) specifying where a frame corresponding to the image data of the subject scene is in the moving image file.

Regarding claim 8, Hagiuda further discloses the print designating method as defined in claim 1, wherein the scene specifying information includes start position (first scene of each moving image file, Fig. 5 and 8, col. 6, lines 21-32 and col. 2, lines 39-54) information of the image data of the subject scene in the moving image file.

Regarding claim 15: Claim 15 recites the limitations that are included in claim 1; therefore, claim 15 is rejected for the same basis/rationale as described in claim 1 above.

2. Claims 2, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiuda (U.S. 5953008), Ito et al's admission of prior art (U.S. 6453071) as applied to claim 1 above, and further in view of Hatori (U.S. 6553382)

Regarding claim 2, the combinations of Hagiuda and Ito's admission of prior art as applied to claim 1 above, do not disclose explicitly, wherein the file specifying information includes at least one of a path indicating a storage location of the subject file and a file number of the subject file.

Hatori, in the same field of endeavor for file specifying information, discloses the file specifying information includes at least one of a path indicating a storage location (storage location, Fig. 16) of the subject file and a file number (file name, Fig. 16) of the subject file.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hagiuda and Ito's admission of prior art as per teachings of Hatori because of the following reasons: (1) to provide an apparatus for editing moving images an excellent in terms of portability (Hagiuda, col. 11, lines 1-5); (2) to prevent errors in editing moving images operation (Hagiuda, col. 11, lines 14-25).

Therefore, it would have been obvious to combine Hagiuda and Ito's admission of prior art with Hatori to obtain the invention as specified in claim 2.

Regarding claim 5, Hatori further discloses the file type identifying information includes an extension (".tif", Fig. 16) of a file name of the subject file.

Regarding claim 6, Hatori further discloses the file type identifying information includes file type information indicating a file type of the subject file, the file type information being included as initial letters (trip.bmp, Fig. 16) of a file name of the subject file.

3. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiuda (U.S. 5953008), Ito et al's admission of prior art (U.S. 6453071) as applied to claim 8 above, and further in view of Fukushima et al (U.S. 6295086).

Regarding claim 9, the combinations of Hagiuda and Ito's admission of prior art as applied to claim 8 above, do not disclose explicitly, wherein the scene specifying information includes start position information of the image data of the subject scene in the moving image file.

Fukushima, in the same field of endeavor for scene specifying information, discloses start position information includes an offset address (data offset, Fig. 11B, col. 2, lines 1-18 and col. 14, lines 8-33) from one of a top of the moving image file and a bottom of a header of the moving image file.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hagiuda and Ito's admission of prior art as per teachings of Fukushima because of the following reasons: (1) to provide an apparatus for editing moving images an excellent in terms of portability (Hagiuda, col. 11, lines 1-5); (2) to prevent errors in editing moving images operation (Hagiuda, col. 11, lines 14-25).

Therefore, it would have been obvious to combine Hagiuda and Ito's admission of prior art with Fukushima to obtain the invention as specified in claim 9.

Regarding claim 10, Fukushima further discloses wherein the scene specifying information further includes information indicating a length (frame size, col. 6, lines 28-42 and col. 10, lines 24-42) of the image data of the subject scene.

4. Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiuda (U.S. 5953008), and to Ito et al's admission of prior art (U.S. 6453071).



Regarding claim 11, Hagiuda discloses a method for designated with print designation information stored in a print designation file in a recording medium in which a file including image data is stored (stores via main storage memory, Fig. 4),

(1) wherein the print designating information includes: file specifying information for specifying a subject file including the image to be printed (image file as a source file, col. 4, lines 29-41 and col. 6, lines 21-32);

(2) and file type identifying information for identifying whether the subject file is a moving image file or a still image file (identifies by MPU, col. 6, lines 21-32),

(3) wherein if the subject file is the moving image file, the print designating information further includes scene specifying information for specifying a subject scene to be printed in the moving image file (thumbnail images, col. 4, lines 29-41 and col. 6, lines 33-41);

(4) reading (reading unit, Fig. 2) the subject file from the recording medium in accordance with the file specifying information; and

(5) determining whether the subject file is the still image file or the moving image file in accordance with the file type identifying information (col. 6, lines 21-32);

However, Hagiuda does not explicitly disclose, wherein the taking the image data out of the subject scene in the moving image file in accordance with the scene specifying information; and printing the image data of the subject scene.

Ito's admission of prior art, in the same field of endeavor for printing selected scenes of moving images and still images, discloses the selected scenes of moving images and/or still images are to be printed by the printer (col. 1, lines 54-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hagiuda as per teachings of Ito's admission of prior art because of the following reasons: (1) to provide an apparatus for editing moving images an excellent in terms of portability (Hagiuda, col. 11, lines 1-5); (2) to prevent errors in editing moving images operation (Hagiuda, col. 11, lines 14-25).

Therefore, it would have been obvious to combine Hagiuda with Ito's admission of prior art to obtain the invention as specified in claim 11.

Regarding claim 17: Claim 17 is the process step claim corresponding to the method claim 11 above. The above rejection rationale/basis from claim 11 above also teach claim 17.

5. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiuda (U.S. 5953008), and to Ito et al and Ito's admission of prior art (U.S. 6453071).

Regarding claim 12, Hagiuda discloses a designating device, comprising: a print designation file preparing device which stores, in a print designation file in a recording medium (Recording medium, Fig. 4) in which a file including image data is stored (image file as a source file, col. 4, lines 29-41 and col. 6, lines 21-32), print designating information to designate an image to be printed stored in the recording medium, wherein the print designating information includes: file type identifying information for identifying (identifies by MPU, col. 6, lines 21-32) whether the subject file is a moving image file or a still image file, wherein if the subject file is the moving image file, the print designating information further includes scene specifying

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information for specifying a subject scene (thumbnail images, col. 4, lines 29-41 and col. 6, lines 33-41) to be printed in the moving image file.

However, Hagiuda does not explicitly disclose, wherein the selected scenes of a moving images are to be printed by a printer.

Ito's admission of prior art, in the same field of endeavor for printing selected scenes of moving images, discloses the selected scenes of moving images are to be printed by the printer (col. 1, lines 54-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hagiuda as per teachings of Ito's admission of prior art because of the following reasons: (1) to provide an apparatus for editing moving images an excellent in terms of portability (Hagiuda, col. 11, lines 1-5); (2) to prevent errors in editing moving images operation (Hagiuda, col. 11, lines 14-25).

Therefore, it would have been obvious to combine Hagiuda with Ito's admission of prior art to obtain the invention as specified in claim 12.

Regarding claim 13, Ito further discloses the print designating device as defined in claim 12, wherein: the print designating device comprises an electronic camera (ref. 201, Fig. 2 and 18, col. 15, lines 26-67) comprising an imaging device and a recording device which encodes and stores image data obtained through the imaging device in the recording medium; and the electronic camera stores (memory unit, Fig. 18, col. 15, lines 26-67) the file including the image data and the print designation file in the recording medium.

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6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiuda (U.S. 5953008), and to Ito et al and Ito's admission of prior art (U.S. 6453071).

Hagiuda discloses:

(1) file specifying information for specifying a subject file including the image to be printed (col. 6, lines 21-32);

(2) and file type identifying information for identifying whether the subject file is a moving image file or a still image file, wherein if the subject file is the moving image file, the print designating information further includes scene specifying information for specifying a subject scene to be printed in the moving image file (col. 6, lines 21-32);

(3) a file type determining device (MPU, col. 6, lines 21-32) which determines whether the subject file is the still image file or the moving image file in accordance with the file type identifying information in the print designation file; and a print controlling device, wherein if the subject file is determined as the still image file by the file type determining device;

(4) a subject file reading device which reads the subject file from the recording medium in accordance with the file specifying information in the print designation file (MPU, col. 6, lines 21-32).

(5) a print designation file reading device (reading unit, Fig. 1) which reads the print designation file in the recording medium;

However, Hagiuda does not explicitly disclose, a printing device for printing an image designated with print designating information stored in a print designation file in a recording medium in which a file including image data is stored, wherein the print designating information includes: the printing device comprises: the print controlling device executes printing of the

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image data in the subject file, wherein if the subject file is determined as the moving image file by the file type determining device, the print controlling device reads the scene specifying information in the print designation file, takes the image data out of the subject scene in the moving image file in accordance with the scene specifying information, and executes printing of the image data of the subject scene.

Ito and Ito's admission of prior art, in the same field of endeavor for printing selected scenes of moving images, discloses a printing device (printer, Fig. 18) for printing an image designated with print designating information stored in a print designation file in a recording medium in which a file including image data is stored, wherein the print designating information includes: the printing device comprises: the print controlling device (printer controller, Fig. 18) executes printing of the image data in the subject file, wherein if the subject file is determined as the moving image file by the file type determining device, the print controlling device reads the scene specifying information in the print designation file, takes the image data out of the subject scene in the moving image file in accordance with the scene specifying information, and executes printing of the image data of the subject scene (col. 1, lines 54-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hagiuda as per teachings of Ito's admission of prior art because of the following reasons: (1) to provide an apparatus for editing moving images an excellent in terms of portability (Hagiuda, col. 11, lines 1-5); (2) to prevent errors in editing moving images operation (Hagiuda, col. 11, lines 14-25).

Therefore, it would have been obvious to combine Hagiuda with Ito's admission of prior art to obtain the invention as specified in claim 14.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiuda (U.S. 5953008), and to Ito et al's admission of prior art (U.S. 6453071) as applied to claim 11 above, and further in view of Pearlman et al. (US patent 5,764,807).

The combinations of Hagiuda and Ito et al's admission of prior art, as discussed above in claim 11, teaches the corresponding method 11. However, combinations of Hagiuda and Ito et al's admission of prior art do not explicitly teach an a program recording medium (a computer readable medium) as recited in the claims.

Pearlman teaches a program recording medium (a computer program product) comprising a computer readable medium and a computer program (Column 2, lines 47-53)

It is desirable to make a processing method portable from a computer to another computer. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to store the processing steps of the method taught by combinations of Hagiuda and Ito et al's admission of prior art in a computer readable medium taught by Pearlman, because the combination makes the processing method portable and therefore increase its application.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (8:30 AM - 5:00 PM).

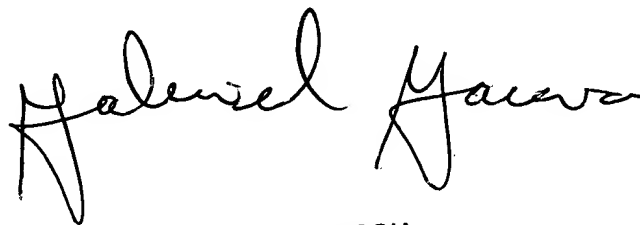
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is (703)308-5397.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Thierry L. Pham

TP  
January 5, 2004

A handwritten signature in black ink, appearing to read 'Gabriel Garcia', written in a cursive style.

GABRIEL GARCIA  
PRIMARY EXAMINER